

P-5319

**IN THE UNITED STATES PATENT AND TRADEMARK OFFICE**

Applicants: Sullivan et al.

Conf. No.: 4080

Serial No.: 09/879,517

Art Unit: 3761

Filing Date: June 12, 2001

Examiner: Erez

Docket No: P-5319

Title: Medicament respiratory delivery device, cartridge and method of making same

Commissioner for Patents  
P.O. Box 1450  
Alexandria, VA 22313-1450

I HEREBY CERTIFY THAT THIS CORRESPONDENCE IS BEING TRANSMITTED TO THE COMMISSIONER FOR PATENTS VIA FACSIMILE NO. (703) 746-4060	
ON: OCTOBER 4, 2004 (DATE OF DEPOSIT)	
BY: <u>Lorraine T. Kownchuk</u> (NAME OF DEPOSITOR)	
<u>Lorraine T. Kownchuk</u> (SIGNATURE)	<u>10/4/04</u> (DATE)

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OCT 04 2004**RESPONSE TO JUNE 4, 2004 OFFICE ACTION**

Sir:

A timely response to the Office Action, which had a three-month period of response, was due no later than September 4, 2004. Thus, this response is being filed with a request for extension of time herewith.

Please amend the above-identified application as follows:

Amendments to the Claims are reflected in the listing of claims, which begin on page 2 of this paper.

Remarks begin on page 20 of this paper.

A Terminal Disclaimer is also attached to this paper.

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02 091809 215 00 00  
04 091809 215 00 00

PTO/SB/28 (08-03)

Approved for use through 07/31/2008. OMB 0661-0031

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**TERMINAL DISCLAIMER TO OBIATE A DOUBLE PATENTING  
REJECTION OVER A PRIOR PATENT**

Docket Number (Optional)

P-5319

In re Application of: Sullivan

Application No.: 09/879,517

Filed: June 12, 2001

For: Medicament Respiratory Delivery Device, Cartridge, and Method of Making same

The owner\*, Becton, Dickinson and Company of 100 percent interest in the instant application hereby disclaims, except as provided below, the terminal part of the statutory term of any patent granted on the instant application, which would extend beyond the expiration date of the full statutory term defined in 35 U.S.C. 154 and 173, as presently shortened by any terminal disclaimer, of prior Patent No. 6,644,309. The owner hereby agrees that any patent so granted on the instant application shall be enforceable only for and during such period that it and the prior patent are commonly owned. This agreement runs with any patent granted on the instant application and is binding upon the grantee, its successors or assigns.

In making the above disclaimer, the owner does not disclaim the terminal part of any patent granted on the instant application that would extend to the expiration date of the full statutory term as defined in 35 U.S.C. 154 and 173 of the prior patent, as presently shortened by any terminal disclaimer, in the event that it later expires for failure to pay a maintenance fee, is held unenforceable, is found invalid by a court of competent jurisdiction, is statutorily disclaimed in whole or terminally disclaimed under 37 CFR 1.321, has all claims canceled by a reexamination certificate, is reissued, or is in any manner terminated prior to the expiration of its full statutory term as presently shortened by any terminal disclaimer.

Check either box 1 or 2 below, if appropriate.

1. ☐ For submissions on behalf of an organization (e.g., corporation, partnership, university, government agency, etc.), the undersigned is empowered to act on behalf of the organization.

I hereby declare that all statements made herein of my own knowledge are true and that all statements made on information and belief are believed to be true; and further that these statements were made with the knowledge that willful false statements and the like so made are punishable by fine or imprisonment, or both, under Section 1001 of Title 18 of the United States Code and that such willful false statements may jeopardize the validity of the application or any patent issued thereon.

2. ☒ The undersigned is an attorney or agent of record.

Signature

Date

Robert E. West, Reg. No. 48,030

Typed or printed name

(201) 847-8782

Telephone Number

- ☒ Terminal disclaimer fee under 37 CFR 1.20(d) included.

**WARNING:** Information on this form may become public. Credit card information should not be included on this form. Provide credit card information and authorization on PTO-2038.

\*Statement under 37 CFR 3.73(b) is required if terminal disclaimer is signed by the assignee (owner).  
Form PTO/SB/96 may be used for making this certification. See MPEP § 324.

This collection of information is required by 37 CFR 1.321. The information is required to obtain or retain a benefit by the public which is to file (and by the USPTO to process) an application. Confidentiality is governed by 35 U.S.C. 122 and 37 CFR 1.14. This collection is estimated to take 12 minutes to complete, including gathering, preparing, and submitting the completed application form to the USPTO. Time will vary depending upon the individual case. Any comments on the amount of time you require to complete this form and/or suggestions for reducing this burden, should be sent to the Chief Information Officer, U.S. Patent and Trademark Office, U.S. Department of Commerce, P.O. Box 1480, Alexandria, VA 22313-1480. DO NOT SEND FEES OR COMPLETED FORMS TO THIS ADDRESS. SEND TO: Commissioner for Patents, P.O. Box 1460, Alexandria, VA 22313-1460.

If you need assistance in completing the form, call 1-800-PTO-9199 and select option 2.

PTO/SB/22 (08-03)

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<b>PETITION FOR EXTENSION OF TIME UNDER 37 CFR 1.136(a)</b>		Docket Number (Optional) P-5319
In re Application of Sullivan, et al.		
Application Number 09/879,517	Filed June 12, 2001	
For Medicament respiratory delivery device, cartridge and method of making		
Art Unit 3761	Examiner Erez	

This is a request under the provisions of 37 CFR 1.136(a) to extend the period for filing a reply in the above identified application.

The requested extension and appropriate non-small-entity fee are as follows (check time period desired):

☒ One month (37 CFR 1.17(a)(1)) \$ 110.00

☐ Two months (37 CFR 1.17(a)(2)) \$ \_\_\_\_\_

☐ Three months (37 CFR 1.17(a)(3)) \$ \_\_\_\_\_

☐ Four months (37 CFR 1.17(a)(4)) \$ \_\_\_\_\_

☐ Five months (37 CFR 1.17(a)(5)) \$ \_\_\_\_\_

☐ Applicant claims small entity status. See 37 CFR 1.27. Therefore, the fee amount shown above is reduced by one-half, and the resulting fee is: \$ \_\_\_\_\_

☐ A check in the amount of the fee is enclosed.

☐ Payment by credit card. Form PTO-2038 is attached.

☐ The Director has already been authorized to charge fees in this application to a Deposit Account.

☒ The Director is hereby authorized to charge any fees which may be required, or credit any overpayment, to Deposit Account Number 02-1666.

I have enclosed a duplicate copy of this sheet.

I am the ☐ applicant/inventor.

☐ assignee of record of the entire interest. See 37 CFR 3.71.  
Statement under 37 CFR 3.73(b) is enclosed (Form PTO/SB/98).

☒ attorney or agent of record. Registration Number 48,030

☐ attorney or agent under 37 CFR 1.34(a).  
Registration number if acting under 37 CFR 1.34(a) \_\_\_\_\_

**WARNING: Information on this form may become public. Credit card information should not be included on this form. Provide credit card information and authorization on PTO-2038.**

9-28-2004  
Date

Robert E. West  
Signature

201-847-6782  
Telephone Number

Robert E. West  
Typed or printed name

NOTE: Signatures of all the inventors or assignees of record of the entire interest or their representative(s) are required. Submit multiple forms if more than one signature is required, see below.

☒ Total of 1 forms are submitted.

This collection of information is required by 37 CFR 1.136(a). The information is required to obtain or retain a benefit by the public which is to file (and by the USPTO to process) an application. Confidentiality is governed by 35 U.S.C. 122 and 37 CFR 1.14. This collection is estimated to take 5 minutes to complete, including gathering, preparing, and submitting the completed application form to the USPTO. Time will vary depending upon the individual case. Any comments on the amount of time you require to complete this form and/or suggestions for reducing this burden, should be sent to the Chief Information Officer, U.S. Patent and Trademark Office, U.S. Department of Commerce, P.O. Box 1450, Alexandria, VA 22313-1450. DO NOT SEND FEES OR COMPLETED FORMS TO THIS ADDRESS. SEND TO: Commissioner for Patents, P.O. Box 1450, Alexandria, VA 22313-1450.

If you need assistance in completing the form, call 1-800-PTO-9169 and select option 2.

**PATENT APPLICATION FEE DETERMINATION RECORD**  
Effective October 1, 2000

Application or Docket Number

09/879517

**CLAIMS AS FILED - PART I**

	(Column 1)	(Column 2)
TOTAL CLAIMS	71	
FOR	NUMBER FILED	NUMBER EXTRA
TOTAL CHARGEABLE CLAIMS	71 minus 20 =	51
INDEPENDENT CLAIMS	8 minus 3 =	5
MULTIPLE DEPENDENT CLAIM PRESENT <input type="checkbox"/>		

\* If the difference in column 1 is less than zero, enter "0" in column 2

SMALL ENTITY  
TYPE ☐

OR  
OTHER THAN  
SMALL ENTITY

RATE	FEE		RATE	FEE
BASIC FEE	355.00	OR	BASIC FEE	710.00
X\$ 9=		OR	X\$18=	918
X40=		OR	X80=	400
+135=		OR	+270=	
TOTAL		OR	TOTAL	2028

**CLAIMS AS AMENDED - PART II**

	(Column 1)	(Column 2)	(Column 3)
AMENDMENT A	CLAIMS REMAINING AFTER AMENDMENT	HIGHEST NUMBER PREVIOUSLY PAID FOR	PRESENT EXTRA
Total	83	Minus 71	= 12
Independent	9	Minus 8	= 1
FIRST PRESENTATION OF MULTIPLE DEPENDENT CLAIM <input type="checkbox"/>			

SMALL ENTITY

OR  
OTHER THAN  
SMALL ENTITY

RATE	ADDI- TIONAL FEE		RATE	ADDI- TIONAL FEE
X\$ 9=		OR	X\$18=	216
X40=		OR	X80=	88
+135=		OR	+270=	
TOTAL ADDIT. FEE		OR	TOTAL ADDIT. FEE	304

	(Column 1)	(Column 2)	(Column 3)
AMENDMENT B	CLAIMS REMAINING AFTER AMENDMENT	HIGHEST NUMBER PREVIOUSLY PAID FOR	PRESENT EXTRA
Total		Minus	=
Independent		Minus	=
FIRST PRESENTATION OF MULTIPLE DEPENDENT CLAIM <input type="checkbox"/>			

RATE	ADDI- TIONAL FEE		RATE	ADDI- TIONAL FEE
X\$ 9=		OR	X\$18=	
X40=		OR	X80=	
+135=		OR	+270=	
TOTAL ADDIT. FEE		OR	TOTAL ADDIT. FEE	

	(Column 1)	(Column 2)	(Column 3)
AMENDMENT C	CLAIMS REMAINING AFTER AMENDMENT	HIGHEST NUMBER PREVIOUSLY PAID FOR	PRESENT EXTRA
Total		Minus	=
Independent		Minus	=
FIRST PRESENTATION OF MULTIPLE DEPENDENT CLAIM <input type="checkbox"/>			

RATE	ADDI- TIONAL FEE		RATE	ADDI- TIONAL FEE
X\$ 9=		OR	X\$18=	
X40=		OR	X80=	
+135=		OR	+270=	
TOTAL ADDIT. FEE		OR	TOTAL ADDIT. FEE	

\* If the entry in column 1 is less than the entry in column 2, write "0" in column 3.

\*\* If the "Highest Number Previously Paid For" IN THIS SPACE is less than 20, enter "20."

\*\*\* If the "Highest Number Previously Paid For" IN THIS SPACE is less than 3, enter "3."

The "Highest Number Previously Paid For" (Total or Independent) is the highest number found in the appropriate box in column 1.